

claim 33  
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55. (Once Amended) In a network comprising a user node having a browser program coupled to said network, said user node providing requests for information on said network, a content provider affiliate node having a respective affiliate web site responsive to requests for information from said user node to provide media content, advertising space for display of advertising content and a link message to said user node, and an advertiser node having an advertiser web site including advertising content corresponding to an advertising banner, said advertiser node responsive to a request to provide said advertising content corresponding to the selection of said advertising banner by a user, a network node comprising:

an advertisement server node responsive to a request from said user node based on said link message to select an advertising banner for said advertising space, and to reply to said request from said user node by identifying said advertising banner to said user node,  
wherein said advertisement server node is responsive to a request from said user node to identify an advertiser web site corresponding to said advertising banner, whereby said advertising banner from said advertisement server node is [displayed] <sup>displayed</sup> displayable at said user node in said advertising space, and whereby said advertising content from said selected advertiser node is [displayed] <sup>displayed</sup> displayable at said user node,  
wherein said advertisement server node selects said advertising banner based on <sup>the</sup> a number of times said advertising content has been previously displayed at said user node.

### REMARKS

Throughout this response, Applicants make reference to their April 4, 2001 filing, which included a Preliminary Amendment, inventor declarations under 37 C.F.R. § 1.132, an Information Disclosure Statement and a Notification Regarding Litigation.<sup>1</sup>

Absent entry of the April 4, 2001 filing, claims 1-50 are pending in this Reissue Application, with independent claims 1, 7, 13, 16, 23, 29, 32, 42 and 45. Upon entry of the

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<sup>1</sup> 37 C.F.R. §1.115(b)(1) and the official C.F.R. comments make clear that the Office should have approved entry of the April 4, 2001 filing before the mailing of the April 24, 2001 Office Action. Even though the Examiner had devoted a significant amount of time preparing the Office Action, the April 4, 2001 filing included a Preliminary Amendment requesting minimal changes directed solely to the form of some claims, while also including the disclosure of information that would have obviated a considerable portion of the Examiner's requests in the instant Office Action.

April 4, 2001 filing, additional claims 51-57 (all independent) will also be pending. Applicants have amended claims 1, 7, 13, 16, 20, 23, 32, and 51-55 to more clearly define the present invention. These amendments are not intended as, and should not be construed as, narrowing the scope of the claims, and are not made in response to any prior art rejection.

#### **Interview Summary**

Applicants thank the Office for the routine status call reflected on the Interview Summary sheet. During this call Applicants apprised the Office that the litigation relating to this reissue application had been settled. Applicants respectfully submit that at no point in the conversation was there any mention of the fact that “[a]ny filings after today’s date will be considered in response to the Office Action,” as noted on the Interview Summary.

#### **Disallowance of Extensions of Time Traversed by Applicants**

Applicant’s respectfully traverse the disallowance of extensions of time due to the “related litigation status of this reissue application.” As noted above, Applicants apprised the Examiner that the litigation had settled during a telephone conversation in early April, and on April 4, 2001 filed a Notification Regarding Litigation to that effect, with copies of the stipulations of dismissal attached.

#### **Requirement for Information Under 37 C.F.R. § 105 Already Satisfied**

To comply with the requirement for information under 37 C.F.R. § 105, Applicants direct the Examiner’s attention to the April 4, 2001 filing, which included an Information Disclosure Statement and 37 C.F.R. § 1.132 declarations of inventors Dwight Merriman and Kevin O’Connor. In addition, Applicants are filing herewith an additional Information Disclosure Statement providing materials from the above-mentioned litigation.

#### **Original Patent or Statement as to Loss Under 37 C.F.R. § 1.178 Deferred**

Applicants note the Examiner’s statement regarding submission of the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, to the Patent Office before allowance of this Reissue Application under 37 C.F.R. § 1.178. Applicants intend to comply with this section upon indication of allowance.

### **Rejection Based on Defective Oath/Declaration Traversed**

The Examiner rejected claims 1-50 as being based upon a defective reissue declaration under 35 U.S.C. 251 and 37 C.F.R. 1.175. Applicants respectfully traverse the rejection. On August 25, 2000 Applicants submitted a reissue declaration that states:

We, the inventors, believe that pursuant to 37 C.F.R. 1.175, the original patent, No. 5,948,061, is partly inoperative by reason that we claimed more or less than we had a right to claim in the patent, in that the invention encompasses an advertisement selection technique other than that which was originally claimed. [emphasis added]

The applicants respectfully submit that the above-quoted phrase from the reissue declaration, “the invention encompasses an advertisement selection technique other than that which was originally claimed” meets the requirements of 35 U.S.C. 251 and 37 C.F.R. § 1.175. See MPEP § 1414. Original claim 1 does not include the phrase “based upon the information stored about said user node at said advertisement server node,” which is disclosed in the specification. As such, the patent is deemed partially inoperative with respect to the other advertisement selection technique to which amended claim 1 is directed.

The applicants submit that the above explanation clarifies the meaning of the phrase at issue, and respectfully request the Examiner to reconsider and withdraw the rejection with regard to the reissue declaration.

### **Information Disclosure Statements Supplied**

The Examiner has required Applicants to supply copies of all prior art considered in the issued Patent No. 5,948,061 on an Information Disclosure Statement. In complying with this request, Applicants direct the Examiner to the Information Disclosure Statement filed in the April 4, 2001 filing, and the supplemental Information Disclosure Statement submitted herewith.

### **Formal Drawings To Be Supplied**

The Examiner required new formal drawings in this application because transfer of formal drawings is no longer done by the Patent Office. Applicants intend to comply with this requirement upon indication of allowance.

### **Rejection Based on 35 U.S.C. § 112 Has Been Overcome**

The Examiner rejected claims 1-50 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner states that “[t]here is not sufficient means to support the whereby/wherein clause that discusses displaying the advertising at the user node. This clause states that the content is displayed at the user node but the advertising node is responsive to the request to provide advertising content and there is no request explicitly going to the advertising node to trigger the advertising content.”

Applicants respectfully traverse this rejection. Independent claims 1, 7, 13, 16, 23, and 32, as amended, include wherein or whereby clauses such that the advertising content or advertising banner as recited in the claims is “displayable” at the recited user node. Dependent claim 20, as amended, includes a similar whereby clause. Accordingly, there is no lack of “sufficient means to support the whereby/wherein clause.” The § 112 rejection should be withdrawn from dependent claims 2-6, 8-12, 14-15, 17-19, 21-22, 24-28, and 33-35, dependent from independent claims 1, 7, 13, 16, 23, and 32 for the same reasons as given above.

With respect to claims 29-31 and 36-50, Applicants respectfully submit the stated reason for the § 112 rejection does not apply, as these claims do not recite a whereby/wherein clause that discusses “displaying the advertising at the user node” as referred to by the Examiner.

For these reasons, Applicants respectfully submit that the § 112 rejection of all pending claims be withdrawn.

#### **Kohda, Wexler, Angles Are Removed as Prior Art**

The Examiner rejected various permutations of claims under 35 U.S.C. 102(a), 102 (e) and 103(a) as being anticipated by Kohda (May 1996 article entitled “Ubiquitous advertising on the WWW: Merging advertisement on the browser”), Wexler (U.S. Patent No. 5,960,409, filed 10/11/96) and Angles (U.S. Patent No. 5,933,811, filed 8/20/96).

In addition to the information disclosed in the April 4, 2001 filing, Applicants hereby resubmit from the original prosecution of this application an affidavit under 37 C.F.R. § 1.131, filed December 12, 1998, stating facts which indicate that both conception and reduction to practice of the claimed invention occurred prior to May 1996, the publication

date of Kohda, which is the earliest of the three references. Thus, Applicants respectfully submit that these references have been removed as prior art.

#### **The Claims Are Not Anticipated by Minor**

The Examiner rejected claims 1, 3-4, 7, 9-10, 13, 16, 18-19, 20-21, 23, 25-26, 29, 32, 34-37, 39-40, 42-43, 45, 47-48 under 35 U.S.C. 102(e) as being anticipated by Minor (U.S. Patent No. 5,740,252, filed 10/13/85). Applicants respectfully traverse this rejection, and submit that each pending claim is patentably distinguishable over Minor.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Anticipation does not occur in the instant application, however, because Minor fails to disclose a system or method for selecting an online advertisement based upon information stored about the user node at the advertisement server node.

Each rejected independent claim (claims 1, 7, 13, 16, 23, 29, 32, 42 and 45) requires that the selection of an advertisement be based upon information stored about the user node at the advertisement server node. Minor neither teaches nor discloses selection of an ad based upon information stored about the user node at the advertisement server node. Indeed, Minor does not address selection of advertisements at all. Accordingly, for at least this reason, Minor does not anticipate independent claims 1, 7, 13, 16, 23, 29, 32, 42 and 45.

Furthermore, as each of the dependent claims depend from and further limit their respective independent claims, Applicants respectfully submit that for at least the same reason as above all of the pending dependent claims are not anticipated by Minor under 35 U.S.C. § 102.

#### **The Claims Are Non-Obvious Over Minor**

The Examiner rejected claims 2, 5-6, 8, 11-12, 14-15, 17, 21-22, 24, 27-28, 30-31, 33, 38, 40-41, 43-44, 46, 49-50 under 35 U.S.C. 103(a) as being unpatentable over Minor, either in combination with other references or in combination with knowledge of one of ordinary skill in the art.

With respect to an obviousness rejection under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. §2142. To

establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143.

Applicants respectfully submit that the Examiner does not establish a *prima facie* case of obviousness, because the suggestions or motivations provided by the Examiner do not cure the deficiencies of Minor (the 35 U.S.C. § 102 art) as discussed above. Accordingly, for at least this reason, the obviousness rejections based on Minor should be withdrawn.

Furthermore, the obviousness rejections based upon Kohda, Wexler, and Angles should be withdrawn for the reason that these references have been removed as prior art as discussed above.

#### **Double-Patenting Rejection Over Copending Patent Applications Deferred**

The Examiner provisionally rejected claims 1-4, 7-10, 20, 32-39 and 45-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over assorted claims of copending Application No. 09/094,949 and copending Application No. 09/362,008.

Applicants respectfully request that this rejection be held in abeyance until one of the applications are allowed or the rejection becomes moot via further prosecution of the applications.

#### **CONCLUSION**

The Applicants respectfully submit that the foregoing remarks demonstrate that the Reissue Application is in condition for allowance and prompt notification thereof is requested.

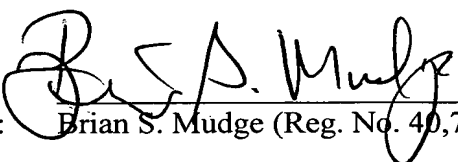
The Examiner is invited to contact Bradley J. Meier, Reg. No. 44,236, or the undersigned to discuss any matter concerning this application.

Although not believed necessary, the Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: July 24, 2001

By:  Brian S. Mudge (Reg. No. 40,738)

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